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09/817,597	03/26/2001	Motoki Nakade	450100-03084	7826

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,597

Applicant(s)

NAKADE ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 and 10-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicants' amendment filed April 1, 2004 is acknowledged. Accordingly, claims 1-8 and 10-22 remain pending.
2. All references in this Office Action to the capitalized versions of "Applicants" refers specifically the Applicants of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
3. This application in an image file wrapper ("IFW") application. Applicants' response is therefore separated before being placed into the IFW system (*i.e.* claims, remarks, drawings, etc. are separated and independently scanned). To ensure proper handling by the Examiner, the Examiner highly recommends Applicants place the application serial no (*e.g.* 06/123,456) in a header or footer (or other appropriate area) of *each* page submitted. At the very least, the Examiner highly recommends this practice for all pages listing the claims.
4. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

Restrictions

5. In The Examiner maintains his position that Inventions I and II are not patentably distinct.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Applicants are again reminded that the claims are replete with these errors. Because of this, the Examiner highly recommends Applicants review all pending claims to ensure that claim phrases that potentially invoke invoking 35 U.S.C. §112 6th paragraph have proper antecedent basis. See 37 C.F.R. §.75(d)(1), MPEP §608.01(o), and MPEP §2181.

Correction of at least the following is required:

- i. The “connecting means for connecting a plurality of communication terminal apparatus” as recited in claim 14.
- ii. The “first means for transmitting audio data” as recited in claim 14.
- iii. The “first means for transmitting audio data” as recited in claim 14.

Claim Rejections - 35 USC §112 1st Paragraph

7. The following is a quotation of the 1st paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-23 are rejected under 35 U.S.C. §112, 1st paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9. In this case, Applicants have claimed embodiment(s) of the invention that are completely outside the scope of the specification. In particular, Applicants have not disclosed “said second

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image being offered directly by the arbitrary communications terminal apparatus utilized by said first user” If Applicants show that such features are found in embodiment(s) as disclosed in Applicants’ original specification or if Applicants expressly admit that such features are old and well known in this art and provide appropriate evidence in support thereof, this particular 35 U.S.C. §112, 1st paragraph rejection will be withdrawn.

Claim Rejections - 35 USC §112 2nd Paragraph

10. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-22 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

- a. In claim 1, the phrase “arbitrary communications terminal” is indefinite since it’s the modifier “arbitrary” can not be reasonably ascertained.
- b. In claims 10 and 11, “said consideration” as recited in approximately line 3 does not have antecedent basis. Appropriate correction is required.
- c. In claim 14, it is unclear if “a first image data” as recited in line 6 is the same or different than “image data” as recited in line 4. For prior art purposes only, the Examiner interprets “a first image data” as data which is different than “image data” recited in line 4.
- d. In claim 14, it is unclear what is the corresponding structure in the “first means for transmitting audio data”

- e. In claim 14, it is unclear what is the corresponding structure in the “first means for transmitting audio data”
 - f. In claim 14, it is unclear what is the corresponding structure in the “second means for transmitting the third image” By using “second,” one of ordinary skill in the art can reasonably infer that the “second means” has similar corresponding structure to the “first means for transmitting audio data.”
 - g. In claim 14, it is unclear if the same “arbitrary communications terminal” is used by both the first and second user.
 - h. Also in claim 14, “the arbitrary communications terminal” as recited in approximately line 10 does not have antecedent basis. Appropriate correction is required.
 - i. Claims 17 is indefinite because the metes and bounds of the claim can not be determined. In particular, it is unclear if the phrase “said connecting means” in claim 17 is ‘in addition to,’ or ‘in replacement of,’ the phrase “the connection means” as recited in claim 14. The Examiner notes that the claims are replete with these types of errors.
12. To help maintain compact prosecution, to avoid additional 35 U.S.C. §112, 2nd paragraph rejections, and (if necessary) to aid Applicants in the event they appeal to the USPTO’s Board of Patent Appeals and Inferences, the Examiner recommends Applicants review their claims and for every means plus function or step plus function invoking 35 U.S.C. §112 6th paragraph and identified by Applicants, Applicants should indicate the claimed function in addition to expressly setting forth the corresponding structure, material, or acts of the particular claimed function by referring to the specification by page and line number and/or drawings with reference to particular characters noted therein. Applicants should consider this actual notice

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that such review and indication as described in this paragraph should be made prior to submitting *any* amendment to the claims. However if Applicants have previously indicated the claimed function and the corresponding structure, material, or acts corresponding to that function, Applicants need only point out their response (with reasonable particularity) in which the indication was made.

13. Regarding the rejections of claims containing 'means plus function' phrases, Applicants are reminded, "For claim clauses containing functional limitations in 'means for' terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification must be presented with sufficient particularity to satisfy the requirements of §112 ¶ 6." *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted). In other words, "[f]ailure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2." *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)).

14. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

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15. Finally, the Examiner notes that except for claim phrases that either successfully invoke lexicography or 35 U.S.C. §112 2nd paragraph, if the face of the claim is indefinite on its face, the entire claim is indefinite. "If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie. *In re Wiggins*, 488 F.2d 538, 541, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted). In this particular case, the findings and conclusions above indicate that the claims are indefinite on their face.

Claim Rejections - 35 USC §103

16. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 14-22, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Burke et. al. (U.S. 6,134,223)("Burke"). Burke discloses the claimed invention but does not directly disclose giving compensation giving to a first user of terminal.

However it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Burke to include giving compensation giving to a user of the terminal. Such a modification would have helped compensate one of the content providers.

18. Claims 1-13, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Burke. Because Invention I is not patentably distinct from Invention II, the patentability of Invention I stands or falls with the patentability of Invention II.

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19. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.¹ First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements² with the required clarity, deliberateness, and precision.³ Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁴ Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined

¹ See the "Second Non Final Office Action" mailed February 22, 2005, Paragraph No. 29; the "First Final Office Action" mailed October 6, 2004, Paragraph No. 19.

² "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

³ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁴ See Note 1.

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the Examiner's express invitation⁵ to be their own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's reasonable conclusion that Applicants have decided not to be their own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁶

20. Under the broadest reasonable interpretation standard noted above and unless modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of

⁵ See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept."

⁶ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

Patent Appeals and Interferences claim interpretations if necessary⁷) during ex parte examination.

21. The Examiner maintains his position that claims 1-13 do not contain any product-by-process claims.

22. Regarding functional language, the Examiner maintains his position as noted in the previous Office Action.

Response to Arguments

23. Applicants' arguments with respect to the claims filed April 1, 2005 have been considered but are not persuasive.

24. Applicants argue that Burke fails to disclose "compensation that is given to a first user of one of said plurality of communication terminal apparatus" First, Virtually all 'compensations' are based at least in part on a predetermined condition. This condition is usually part of a standard offer. See e.g. White and Summers. Additionally, distinguishing between 'users' of an apparatus (or product) is not enough to distinguish the claimed invention over the prior art since who 'uses' an apparatus or product is immaterial to its patentability. Applicants arguments have been considered but are not persuasive.

Conclusion

⁷ See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

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25. Applicants' amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

26. References considered pertinent to Applicants' disclosure are listed on form PTO-892. Unless expressly noted otherwise by the Examiner using appropriate designations on form PTO-892 (*e.g.* page numbers, chapter selections, or other indicia), all references listed on form PTO-892 are cited in their entirety.

27. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

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28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

29. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

30. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding

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claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their “Remarks” (beginning on page 11) traversing the Examiner’s positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁸ the Examiner respectfully reminds Applicants to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner’s positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s immediate supervisor, Robert Olszewski, can be reached at (571) 272-6788. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
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⁸ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.